

### **REMARKS**

In response to the Office Action dated August 4, 2004 ("OA"), Applicants respectfully request the Office to enter the foregoing amendments and to consider the following remarks. Claims 1-20 remain pending in this application. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to our deposit account 06-0916.

In the Office Action of August 4, 2004, the Examiner (i) rejected claims 1, 2, 4-6, 8-10, 14, 16, and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,064,739 to Davis ("Davis") in view of U.S. Patent No. 6,088,801 to Grecsek ("Grecsek"); (ii) rejected claims 3, 7, 15, and 18-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davis in view of Grecsek and further in view of U.S. Patent No. 5,745,678 to Herzberg et al. ("Herzberg"); (iii) rejected claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davis in view of Grecsek and further in view of U.S. Patent No. 6,236,727 to Ciacelli et al. ("Ciacelli"); and (iv) rejected claims 12 and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davis in view of Grecsek and further in view of European Patent No. EP0915620 to Shimada ("Shimada"). Applicants address each of these rejections below.

#### **Rejection of Claims 1, 2, 4-6, 8-10, 14, 16 and 17 under 35 U.S.C. § 103(a)**

Claims 1, 2, 4-6, 8-10, 14, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davis in view of Grecsek.

Claim 1, as amended, recites a method for protecting electronic content from unauthorized use by a user of a computer system. The method includes receiving a user's request to access a piece of electronic content, identifying one or more software modules responsible for processing the electronic content, and denying the request if one or more predefined characteristics of the software modules fail to satisfy a set of predefined criteria.

Applicants respectfully submit that amended claim 1 would not be obvious in view of Davis and Grecsek. In particular, Applicants respectfully submit that neither Davis nor Grecsek disclose, *inter alia*, a method for protecting electronic content from unauthorized use by a user of a computer system, the method including identifying one or more software modules responsible for processing the piece of content, evaluating one or more predefined characteristics of the one or more software modules, and denying the request if the one or more predefined characteristics fail to satisfy a set of predefined criteria.

Instead, Davis describes a "hardware-based security 'envelope' that encapsulates encrypted digital data from the time it is submitted to a computer for decryption and processing until the time it is provided to a display device." (Davis at column 2, lines 58-61). As such, Davis describes a different approach to content protection than claimed by Applicants, and, as a result, as the Examiner concedes, "Davis does not explicitly disclose identifying one or more software modules responsible for processing the piece of electronic content; evaluating one or more predefined characteristics of the one or more software modules; [and] denying the request to access the piece of electronic content if the one or more predefined characteristics fail to satisfy a set of predefined criteria." (OA at page 2, para. 4).

Similarly, Grecsek does not teach a method for protecting electronic content from unauthorized use by a user of a computer system as set forth in claim 1. Instead, Grecsek is concerned with protecting the user's system from external attackers, not from misuse by the user himself. In contrast, claim 1 describes a process for guarding against users who wish to misuse content on their own computers, such as users who wish to access content in a way that would facilitate theft of the content or circumvention of usage constraints placed on the content by the content's owner or distributor.

Moreover, Applicants respectfully submit that there would be no motivation to combine the teachings of Grecsek with those of Davis. As indicated above, Grecsek and Davis address different problems: while Davis seeks to protect content from unauthorized use by employing hardware, Davis seeks to protect users and their systems from malicious software. Because Davis assumes that the user of the computer system cannot be trusted, there would be no motivation to combine the teachings of Davis with those of Grecsek, since Grecsek assumes that the user of the system can be trusted.

In addition, because Davis uses a hardware barrier to protect the software responsible for processing electronic content, Davis assumes that the software has not been, or cannot be, corrupted. Thus, there would be no motivation to combine Davis with the software verification procedures described in Grecsek, since Davis apparently assumes that such procedures are unnecessary.

Thus, while Applicants respectfully submit that the combination of Davis and Grecsek fails to teach all of the elements of Applicants' claim 1, Applicants also respectfully submit that there would be no motivation to make the combination. For at least these reasons, Applicants respectfully submit that claim 1 is patentable over Grecsek and Davis.

Claim 2 is dependent from claim 1, and is thus allowable for at least the reasons set forth above in connection with claim 1.

With respect to claim 4, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of unpatentability. Claim 4 differs substantially from claim 1, yet the Examiner has not indicated where the cited references teach the elements that are unique to claim 4.

In particular, claim 4 recites a system for protecting electronic content having means for applying a cryptographic fingerprint to the electronic content, means for generating an identifier associated with the electronic content, means for monitoring a predefined system interface for data containing the identifier, and means for preventing effective access to data containing the identifier via the predefined system interface.

Although the Examiner concedes that Davis does not teach these aspects of claim 4, the Examiner fails to specifically identify where in Grecsek these elements are allegedly taught. Instead the Examiner simply alleges that it would have been obvious to combine Davis with Grecsek, without explaining how Grecsek would remedy the conceded deficiencies of Davis. Although Applicants respectfully disagree that it would be obvious to combine Davis and Grecsek, for the reasons set forth above, Applicants also respectfully contend that Grecsek fails to teach, *inter alia*, the combination of a means for applying a

cryptographic fingerprint to electronic content, means for generating an identifier associated with the electronic content, means for monitoring a predefined system interface for data containing the identifier, and means for preventing effective access to data containing the identifier via the predefined system interface. For at least these reasons, Applicants respectfully submit that claim 4 is patentable over Grecsek and Davis.

Similarly, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of unpatentability of claim 5. Claim 5 differs substantially from claim 1, yet the Examiner has not indicated where the cited references teach the elements that are unique to claim 5.

For example, claim 5 recites a method for protecting electronic content from unauthorized use, and includes the steps of receiving a request to access a piece of electronic content; generating a first identifier associated with the electronic content; and monitoring at least one system interface by generating a second identifier associated with a piece of received electronic data, comparing the second identifier with the first identifier, and taking a predefined defensive action if the second identifier is related to the first identifier in a predefined manner.

Although the Examiner concedes that Davis does not teach these elements, the Examiner simply indicates, with respect to Grecsek, that the "same rationale applies here as above in rejecting claim 1." (OA at page 5). Applicants respectfully submit, however, that because claim 5 differs substantially from claim 1, such a conclusory rejection is inappropriate, as it fails to adequately apprise Applicants of the Examiner's precise allegations of unpatentability, so that arguments, or amendment to the claims (if necessary)

could be provided. In any event, Applicants respectfully submit that Grecsek fails to teach or suggest, *inter alia*, the combination of generating a first identifier associated with electronic content, and monitoring at least one system interface by generating a second identifier associated with a piece of received electronic data, comparing the second identifier with the first identifier, and taking a predefined defensive action if the second identifier is related to the first identifier in a predefined manner. For at least these reasons, Applicants respectfully submit that claim 5 is patentable over Grecsek and Davis.

Claims 6, 8-10, 14, 16 and 17 are dependent from claim 5, and are thus allowable for at least the reasons set forth above in connection with claim 5.

Rejection of Claims 3, 7, 15, and 18-20 under 35 U.S.C. § 103(a)

Claims 3, 7, 15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Grecsek and further in view of Herzberg. However, claim 3 is dependent from claim 1, and claims 7, 15, and 18-20 are dependent from claim 5, and are thus allowable for at least the reasons set forth above in connection with claims 1 and 5, respectively.

Rejection of Claim 11 under 35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Grecsek and further in view of Ciacelli. However, claim 11 is dependent from claim 5, and is thus allowable for at least the reasons set forth above in connection with claim 5.

Rejection of Claims 12 and 13 under 35 U.S.C. § 103(a)

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Grecsek and further in view of Shimada. However, claims 12 and 13 are dependent from claim 5, and are thus allowable for at least the reasons set forth above in connection with claim 5.


**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request that the Examiner enter this Amendment and pass the pending claims to issuance. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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